

### **REMARKS**

Claims 1-3 and 5-15 are all the claims pending in the application. Claim 4 has been canceled without prejudice or disclaimer. Reconsideration and allowance of all the claims are respectfully requested in view of the following remarks.

#### **Drawings**

The Examiner has not indicated approval of the drawings filed August 28, 2003. Applicant respectfully requests that the Examiner indicate approval of the drawings in the next Office Action.

#### **Specification**

The Examiner objected to the specification because of informalities. Specifically, the Examiner asserted that the reference to U.S. Patent 6,495,932 (pg. 13, line 10) is incorrect. Applicant has corrected this patent number to read "6,276,065". Applicant has also corrected other informalities.

#### **Claim Rejections - 35 U.S.C. § 112**

The Examiner rejected claims 1-15 under § 112, 2<sup>nd</sup> paragraph. Applicant has amended the claims in a manner believed to overcome this rejection. Specifically, Applicant has amended the phrase "extending in its axial direction" to --extending in a reciprocating direction thereof--, and has amended claim 14 so as to depend from claim 13.

#### **Claim Rejections - 35 U.S.C. § 102**

The Examiner rejected claims 1, 3, 6, 7 and 15 under § 102(e) as anticipated by US Patent 6,508,151 to Neitzell (hereinafter Neitzell). Applicant respectfully traverses this rejection for at least the following reasons.

With respect to claims 1, 3, and 6, this rejection is believed to be moot, as Applicant has incorporated the subject matter of allowable claim 4 into independent claim 1.

With respect to claim 7, Neitzell fails to disclose all of the elements as set forth and arranged in the claim. Claim 7 sets forth a saber saw comprising: a plunger capable of reciprocative motion with respect to a housing; a guide sleeve guiding the plunger; and a moving mode changing means for changing a moving mode of the guide sleeve, wherein the guide sleeve is pivotally moved during reciprocation of the plunger.

Claim 15 sets forth a saber saw comprising: a plunger capable of reciprocative motion with respect to a housing; and a guide sleeve guiding the plunger, the guide sleeve being pivotally movable during reciprocation of the plunger.

In contrast to that set forth in claims 7 and 15, Neitzell discloses a track member 56 (corresponding to the guide sleeve of the presently claimed invention) that is not pivotally moved during reciprocation of a spindle 24, even though the track member 56 is pivotally mounted to a housing insert 66 by a pivot member 68.

For at least the above reasons, Neitzell fails to anticipate claims 7 and 15.

**Claim Rejections - 35 U.S.C. § 103**

The Examiner rejected claims 2, 8 and 12 under § 103(a) as being unpatentable over Neitzell. Applicant respectfully traverses this rejection because Neitzell fails to teach or suggest all of the elements as set forth in the claims.

With respect to claim 2, this rejection is now believed to be moot.

Claim 8 depends from claim 7, and claim 12 includes the same above-noted elements as does claim 15. Therefore, as noted above, Neitzell is deficient in that it does not teach or suggest a guide sleeve that is pivotally movable during reciprocation of the plunger.

The Examiner asserts that it would have been obvious to modify Neitzell to have a guide sleeve pivot between a certain angular range to facilitate cutting. However, the Examiner does not set forth any motivation for modifying Neitzell to include a guide sleeve that is pivotally movable during reciprocation of the plunger, as set forth in claims 8 and 12.

For at least the above reasons, Neitzell fails to render obvious Applicant's claims 8 and 12.

### **Double Patenting**

The Examiner rejected claim 9 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5-7 of U.S. Patent No. 6,634,107.

Also, the Examiner rejected claims 1 and 7 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5-7 of U.S. Patent No. 6,634,107 in view of Neitzell.

In response to these double patenting rejections, Applicant has filed herewith a Terminal Disclaimer. As noted in *Quad Environmental Technologies*, the filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting and raises neither presumption nor estoppel on the merits of the rejection. It is improper to convert this simple expedient of “obviation” into an admission or acquiescence or estoppel on the merits.<sup>1</sup>

### **Allowable Subject Matter**

The Examiner indicated that claim 9 would be allowable if rewritten to overcome the §112, 2<sup>nd</sup> paragraph rejections, and to include a terminal disclaimer. In light of the above, Applicant respectfully submits that claim 9 is now in condition for immediate allowance.

Additionally, the Examiner indicated that claims 4, 5, 10, 11, 13 and 14 would be allowable if rewritten to overcome the § 112, 2<sup>nd</sup> paragraph rejections, if rewritten in independent form, and a terminal disclaimer was filed. Claim 1 has been amended to include the subject matter of claim 4 and, in light of the above, should be in condition for immediate allowance together with dependent claims 2, 3, 5, and 6. Applicant thanks the Examiner for indicating that claims 10, 11, 13, and 14 would be allowable if rewritten in independent form, but Applicant has not done so because of the belief that independent claims 9 and 12 are allowable as written.

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<sup>1</sup> *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ.2d 1392, 1394, 1395 (Fed. Cir. 1991).

**Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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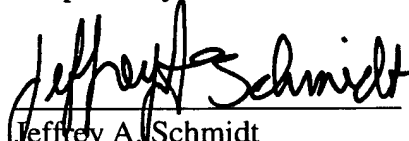
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